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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,328	12/06/2000	Nischal Abrol	PA010054	1479
23696	7590	06/23/2005	EXAMINER	
Qualcomm Incorporated Patents Department 5775 Morehouse Drive San Diego, CA 92121-1714			HSU, ALPUS	
			ART UNIT	PAPER NUMBER
			2665	

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/732,328

Applicant(s)

ABROL ET AL.

Examiner

Alpus H. Hsu

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2665

1. Applicant's arguments with respect to claims 1, 4-13 have been considered but are moot in view of the new ground(s) of rejection.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 9 is rejected under 35 U.S.C. 102(e) as being anticipated by MADOUR in Pub. No. US 2002/0021681 (newly cited).

Referring to claim 9, MADOUR discloses a method of performing a handoff of a mobile station from a first radio access network to a second radio access network, the method comprising: identifying the first radio access network as a first type of radio access network and the second radio access network as a second type of radio access network (paragraph [0010], lines 1-15); and initiating a mobile re-registration based on said identifying (paragraph [0010], lines 15-18).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

Art Unit: 2665

claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over MADOUR in Pub. No. US 2002/0021681 (newly cited) in view of YUN et al. in Pub. No. US 2002/0067692 (of record).

Referring to claims 10 and 11, MADOUR differs from the claims, in that, it does not disclose the networks being lx type and high data rate (HDR) type, which is also well known in the art and commonly applied in wireless communications field. YUN et al., for example, from the similar field of endeavor, teaches the application utilizing networks of lx type and high data rate (HDR) type (paragraph [0013], lines 1-3, paragraph [0025], lines 1-19), which can be easily adopted by one of ordinary skill in the art to implement into the method of MADOUR to conform with system standard and requirement.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over MADOUR in Pub. No. US 2002/0021681 (newly cited) in view of YUN et al. in Pub. No. US 2002/0067692 and MORALES et al. in U.S. Pub. No. US 2002/0067707 (both of records).

Referring to claim 12, MADOUR differs from the claim, in that, it does not disclose the networks being lx type and high data rate (HDR) type, and a sub-step of resetting a Unicast Access Terminal Identifier (UATI) which are well known in the art and commonly applied in wireless communications field. YUN et al., for example, from the similar field of endeavor,

Art Unit: 2665

teaches the application utilizing networks of lx type and high data rate (HDR) type (paragraph [0013], lines 1-3, paragraph [0025], lines 1-19). MORALES et al., also from the similar field of endeavor, teaches the use of Unicast Access Terminal Identifier (UATI) (paragraph [0056], lines 1-11). Both of which can be easily adopted by one of ordinary skill in the art to implement into the method of MADOUR to conform to system standard and requirement.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over MADOUR in Pub. No. US 2002/0021681 (newly cited) in view of YUN et al. in Pub. No. US 2002/0067692 and CONNOLLY et al. in U.S. Patent No. 5,657,375 (both of records).

Referring to claim 13, MADOUR differs from the claim, in that, it does not disclose the networks being lx type and high data rate (HDR) type, and a sub-step of sending a Location Response message which are well known in the art and commonly applied in wireless communications field. YUN et al., for example, from the similar field of endeavor, teaches the application utilizing networks of lx type and high data rate (HDR) type (paragraph [0013], lines 1-3, paragraph [0025], lines 1-19). CONNOLLY et al., also from the similar field of endeavor, teaches the transmission of Location Response message (col. 21, line 40, col. 25, line 35). Both of which can be easily adopted by one of ordinary skill in the art to implement into the method of MADOUR to conform to system standard and requirement.

9. Claims 1, 4, 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over LIOY in U.S. Patent No. 6,665,537 (of record) in view of JOONG et al. in U.S. Patent No. 6,163,704 (newly cited).

Referring to claim 1, LIOY discloses a method of performing a handoff of a mobile station between a first radio access network of a first type and a second radio access network of a

Art Unit: 2665

second type, comprising: determining, at the mobile station, when the handoff should be initiated (col. 9, lines 39-63); and triggering, at the mobile station, a re-registration whenever the mobile station changes its network point of attachment (col. 10, lines 5-21).

LIOY differs from the claim, in that, it does not disclose the feature of triggering the re-registration of a network address of the mobile station if changing from communicating over the first radio access network to communicating over the second radio access network will cause routing ambiguity for data sent to and from the mobile station, which is well known in the art and commonly applied in wireless communications field for fault recovery purpose.

JOONG et al., for example, from the similar field of endeavor, teaches the feature of triggering the re-registration of a network address of the mobile station if changing from communicating over the first radio access network to communicating over the second radio access network will cause routing ambiguity for data sent to and from the mobile station (col. 3, lines 9-15, col. 7, lines 21-32), which can be easily adopted by one of ordinary skill in the art to implement into the method in LIOY to provide the method with automatic fault recovery mechanism to further improve the system reliability and efficiency.

Referring to claim 8, LIOY discloses a sub-step of sending a fake origination to said second radio access network (col. 9, line 65 to col. 10, line 1).

Referring to claim 4, LIOY discloses a mobile station (104), comprising: a control processor, and a memory coupled to the control processor and containing instructions executable by the processor to determine, at the mobile station, when the handoff should be initiated (col. 9, lines 39-63); and trigger, at the mobile station, a re-registration whenever the mobile station changes its network point of attachment (col. 10, lines 5-21).

Art Unit: 2665

LIOY differs from the claim, in that, it does not disclose the feature of triggering the re-registration of a network address of the mobile station if changing from communicating over the first radio access network to communicating over the second radio access network will cause routing ambiguity for data sent to and from the mobile station, which is well known in the art and commonly applied in wireless communications field for fault recovery purpose.

JOONG et al., for example, from the similar field of endeavor, teaches the feature of triggering the re-registration of a network address of the mobile station if changing from communicating over the first radio access network to communicating over the second radio access network will cause routing ambiguity for data sent to and from the mobile station (col. 3, lines 9-15, col. 7, lines 21-32), which can be easily adopted by one of ordinary skill in the art to implement into the method in LIOY to provide the method with automatic fault recovery mechanism to further improve the system reliability and efficiency.

Referring to claim 5, LIOY discloses a mobile station (104), comprising: means for determining, at the mobile station, when the handoff should be initiated (col. 9, lines 39-63); and triggering, at the mobile station, a re-registration whenever the mobile station changes its network point of attachment (col. 10, lines 5-21).

LIOY differs from the claim, in that, it does not disclose the feature of triggering the re-registration of a network address of the mobile station if changing from communicating over the first radio access network to communicating over the second radio access network will cause routing ambiguity for data sent to and from the mobile station, which is well known in the art and commonly applied in wireless communications field for fault recovery purpose.

JOONG et al., for example, from the similar field of endeavor, teaches the feature of triggering the re-registration of a network address of the mobile station if changing from communicating over the first radio access network to communicating over the second radio access network will cause routing ambiguity for data sent to and from the mobile station (col. 3, lines 9-15, col. 7, lines 21-32), which can be easily adopted by one of ordinary skill in the art to implement into the method in LIOY to provide the method with automatic fault recovery mechanism to further improve the system reliability and efficiency.

10. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being obvious over LIOY et al. in U.S. Patent No. 6,665,537 (of record) in view of JOONG et al. in U.S. Patent No. 6,163,704 (newly cited), as applied to claim 1 above, and further in view of PURNADI et al. in U.S. Patent No. 6,708,031 (of record).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another" (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this

Art Unit: 2665

rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP 706.024(1)(1) and 706.024(1)(2).

Referring to claims 6 and 7, the method provided from the teaching of LIOY in view of JOONG et al. differs from the claims, in that, it does not disclose the feature of using subnet mask and packet zone ID for determining the communicating change from one network to another, which is well known in the art and commonly applied in wireless communications field.

PURNADI et al., for example, from the similar field of endeavor, teaches the uses of subnet mask and packet zone ID for determining the communicating change from one network to another (col. 6, lines 42-46, col. 8, lines 26-35), which can be easily adopted by one of ordinary skill in the art to implement into the method provided from the teaching of LIOY in view of JOONG et al. to conform with system standard and requirement.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Williams, Kuehnel et al., Dent et al., and Alvesalo et al. are additionally cited to show the feature of re-registration of mobile station when handoff is initiated similar to the claimed invention.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alpous H. Hsu whose telephone number is (571)272-3146. The examiner can normally be reached on M-F (5:30-3:00) First Friday Off.

Art Unit: 2665

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D. Vu can be reached on (571)272-3155. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AHH



Alpus H. Hsu
Primary Examiner
Art Unit 2665